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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/616,674 | 07/10/2003 | Carl A. Forest | 023604.0102PTUS | 2594 |

24283 7590 07/02/2008

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| EXAMINER | |
|---|---|
| ROGERS, JAMES WILLIAM | |
| **ART UNIT** | **PAPER NUMBER** |
| 1618 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/02/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/616,674 | FOREST, CARL A. | |
| | Examiner | Art Unit | |
| | JAMES W. ROGERS | 1618 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6 and 9-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 9-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

### *Claim Rejections - 35 USC § 112*

**Claims 1-6 and 9-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement**, for the reasons set forth in the prior office action filed 09/10/2007.

Applicant's arguments filed 01/10/2008 have been fully considered but they are not persuasive.

Applicants assert that the limitation within claims 1 and 26 which states “said weight loss supplement no including a fat blend" is a limitation made to exclude something disclosed in the reference of record and that such amendments have always been viewed by the USPTO and courts as a narrowing amendment and deemed to be supported within the specification. Furthermore applicants assert that none of the many weight loss supplements recited within the specification include a fat blend. Applicants further assert that the specification includes only substances or formulations that are recognized as weight loss supplements in the art of weight loss food supplements and thus one skilled in the art would clearly understand that the term "weight loss supplement" in the claims is not intended to include the fat blends of Sundram.

The examiner respectfully disagrees with the above assertions by applicants. Firstly in order to exclude a species within a given claim set the specification as originally filed must have at least described such a species, no where within applicant's specification is a fat blend even mentioned, thus applicants cannot exclude this element

since it is not disclosed. Secondly just because applicants did not use a fat blend within their examples does not mean that it is excluded from the claims which are much broader in regards to their scope than applicant's examples. Furthermore the transitional phrase "comprising" within applicants claims does not exclude a fat blend from being present within the salad dressing. The transitional term "comprising", which is synonymous with "including", "containing", or "characterized by", is inclusive or open ended and does not exclude additional elements or method steps recited in the prior art. Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). Regarding applicants assertion that a fat blend such as the blend of Sundrum is not encompassed within the term "weight loss supplement", while the examiner disagrees and does not concede that the term excludes the fat blend of Sundrum, even if it would be obvious to one of ordinary skill in the art that "weight loss supplement" could exclude a fat blend, it is never the less not disclosed. A description that does not render a claimed invention obvious does not sufficiently describe that invention. But a description that renders obvious a claimed invention does not necessarily satisfy the written description requirement. Eli Lilly, 119 F.3d at 1567, 43 USPQ2d at 1405. Also see In re Ruschig, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) ("If n-propylamine had been used in making the compound instead of n-butylamine, the compound of claim 13 would have resulted. Appellants submit to us, as they did to the board, an imaginary specific example patterned on specific example 6 by which the above butyl compound is made so that we can see what a simple change would have resulted in a specific supporting disclosure being present in the present

specification. The trouble is that there is no such disclosure, easy though it is to imagine it.") (emphasis in original); Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000).

**Claims 1-6 and 9-28 rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons set forth in the prior office action filed 09/10/2007.

Applicant's arguments filed 01/10/2008 have been fully considered but they are not persuasive.

Applicants assert that the term fat blend does not have to be defined within the specification since it is a term of art as shown within the reference cited by the examiner Sundrum.

Regarding Sundrum, this reference describes a narrow group of blends that are called fat blends, however the reference in no way describes each and every fat blend known to man. Essentially since applicants have not defined what a fat blend is and the scope of the term is debatable the claim does not clearly demonstrate what the phrase excludes.

**Claims 1-6, 9-30 remain rejected under 35 U.S.C. 103(a)** as being unpatentable over Sundram et al. US 20020034562 in view of McCleary US 6,579,866 (McCleary), Hastings US 5626849 (Hastings), and further in view of Dente US 6277396 (Dente) for the reasons set forth in the office action filed 09/10/2007.

Applicant's arguments filed 01/10/2008 have been fully considered but they are not persuasive.

Applicants assert that Sundrum does not teach the use of salad dressing as a carrier for a composition to achieve a health advantage; rather applicants assert a fat blend is combined with a salad dressing. Applicants assert that adding this fat blend to the salad dressing does not suggest addition of an ingredient that actively promotes weight loss. Applicants then assert that the examiner argues that combining medicines in salad dressings and drinks is well known in the art and provides three references as evidence but the references are not relevant for this teaching.

The examiner respectfully disagrees with the above assertions by applicants. Clearly Sundrum discloses that the fat blend which can be formulated in food products including salad dressings can be used for managing and controlling food intake such as for weight loss, the examiner considers this to clearly read on a weight loss supplement. Regarding applicants assertions on the three references relied on, these references were only used as evidence to show that active ingredients including medicines **and/or nutritional supplements** were well known in the art to be added to salad dressing and were used to rebut the declaration by applicants. The references were only used as evidence that people skilled in the art would consider salad dressing as a carrier for medicines and/or nutritional supplements.

## Double Patenting

Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, filed 01/10/2008, with respect to the double patenting rejection over

6,579,866 have been fully considered and are persuasive. The double patenting rejection over 6,579,866 has been withdrawn.

***Conclusion***

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618

| Application Number | Application/Control No. | Applicant(s)/Patent under Reexamination | |
|---|---|---|---|
| | 10/616,674 | FOREST, CARL A. | |
| | Examiner | Art Unit | |
| | JAMES W. ROGERS | 1618 | |